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| EXAMINER |
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NEGRELLI, KARA B

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| ART UNIT | PAPER NUMBER |
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1796

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12/08/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentgroupus@unilever.com

| | | | |
|------------------------------|--------------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 10/587,732 | Applicant(s) COOPER ET AL. | |
| | Examiner KARA NEGRELLI | Art Unit 1796 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 2,3,9 and 22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4, 5-8, and 10-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

POROUS BODIES AND METHOD OF PRODUCTION THEREOF

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 12, 2009 has been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action. Claims 1-22 are pending.
3. Any rejections stated in the previous Office Action and not repeated below are withdrawn.

Terminal Disclaimer

4. The terminal disclaimer filed on October 23, 2009 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of copending Application No. 10/587,734 and copending Application No. 10/587,722 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 4-8, 10-11 and 13-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wu et al. (US 5,025,004), as evidenced by Steiner et al. (US 4,888,420) and Pruss et al. (US 2003/0215502).

7. Wu et al. teach processes for forming lattice-like materials comprising 0.5% to 70% (column 4, lines 18-20) of at least one oil-in-water surfactant material (column 3, lines 51-55), from 5 to 35 weight percent of a material which may comprise cellulose acetate (column 4, lines 14-15 and column 6, line 11), and further comprising at least one of a UV absorber (such as 2 hydroxy-4-methoxy benzophenone or 2-ethylhexyl salicylate, which are water insoluble); fragrances such as lemon oil or orange oil (which are water insoluble materials); and/or Vitamin E derivatives such as Vitamin E succinate (of which Vitamin E succinate is a water-soluble form of vitamin E, pertaining to instant claim 8).

8. Although Wu et al. describes cellulose acetate as a water insoluble polymer, cellulose acetate materials, including cellulose acetate phthalate, are soluble in water. See Steiner et al., column 2, lines 42-44. Furthermore, the instant specification acknowledges that cellulose derivatives which are soluble in water include cellulose acetate (see paragraphs [0071]-[0073]). Case law holds that a material and its properties are inseparable. *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

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9. The oil-in-water surfactant material may comprise polyoxyethylene sorbitan tristearate, which is a waxy solid at room temperature with an HLB value of about 10.5 (see attached Data Sheet: Polyoxyethylene (20) Sorbitan Tristearate) (pertaining to instant claims 5-7 and 14-17).

10. The lattice-like materials of Wu et al. include dried (including freeze-dried, see column 3, line 14 and column 8, lines 12-20), powdered polymeric materials may have a particle size in the range of from 10 μm to 30 μm (meaning the particles are not spheres with a diameter of from 0.2 to 0.5 mm). See column 8, lines 37-39).

11. The composition further comprises 1 to 65% of a water-in-oil emulsifying agent, which may comprise a hydrocarbon with a chain length of 18 carbons, an ester of a monoglyceride, or a sulfonated ester (see column 6, line 65 to column 7, line 20) (pertaining to instant claims 18-20).

12. In a typical freeze-drying process, a dispersion is placed in a suitable vessel and frozen (by means of a fluid freezing medium) to a temperature of about -5°C to -100°C (a temperature sufficient to rapidly freeze a liquid medium). The frozen dispersion is then subjected to reduced pressure. Under conditions of reduced pressure and reduced temperature, the frozen solvent is removed by sublimation yielding a solid, porous material. See paragraph [0111] of Pruss et al.

13. The amounts of surfactant and polymeric (cellulose acetate) material taught in Wu et al. overlap the instantly claimed ranges of surfactant and water-soluble polymeric material. The amount of hydrocarbon material of Wu et al. overlaps the ranges of instant claims 18-19. It is well settled that where the prior art describes the components of a

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claimed compound or compositions in concentrations within or overlapping the claimed concentrations a prima facie case of obviousness is established. See *In re Harris*, 409 F.3d 1339, 1343, 74 USPQ2d 1951, 1953 (Fed. Cir 2005); *In re Peterson*, 315 F.3d 1325, 1329, 65 USPQ 2d 1379, 1382 (Fed. Cir. 1997); *In re Woodruff*, 919 F.2d 1575, 1578 16 USPQ2d 1934, 1936-37 (CCPA 1990); *In re Malagari*, 499 F.2d 1297, 1303, 182 USPQ 549, 553 (CCPA 1974).

14. Wu et al. do not elaborate on the intrusion volume of the lattice-like polymeric materials of the invention. However, Wu et al. teach identical materials which may used in identical amounts as disclosed in the instantly claimed application. The powdered materials of Wu et al. may also be produced using a freeze-drying process, which is taught in the instant invention. One of ordinary skill in the art would therefore reasonably expect the compositions of Wu et al. to exhibit the same properties as the instantly claimed invention, including the specified intrusion volume. Case law holds that a material and its properties are inseparable. *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

15. The limitation of claim 1 which teaches that the "water insoluble material incorporated into said lattice to be dispersed when the water soluble porous body dissolves" is a future intended use and describes what may happen to the porous bodies of the invention when dissolved in a substance. Case law holds that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the

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intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Because Wu et al. teach the same materials which may be used in the same amounts to form lattice-like polymeric material, as are taught in the instant application, it is the examiner's position that the polymeric materials of Wu et al. are not structurally different than the porous bodies of the instant invention and would therefore behave the same.

16. It is noted that while instant claim 21 claims a solutions or dispersions, claim 21 is recited in the product-by-process format by use of the language, "Solutions or dispersions comprising water soluble polymeric materials and surfactant formed by..."

Case law holds that:

Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. See *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

17. To the extent that the process limitations in a product-by-process claim do not carry weight absent a showing of criticality, the reference discloses the claimed product in the sense that the prior art product structure is seen to be no different from that indicated by the claims.

18. In addition, instant claim 21 teaches a future intended use for the porous bodies of instant claim 1. Case law holds that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

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See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

19. Claims 1, 4-8, and 10-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pruss et al. (US 2003/0215502).

20. Pruss et al. teach a composition for forming tablets, said composition of which may comprise from 0.1 to 99.9 wt% of xanthan gum (see paragraphs [0085]-[0086] and paragraph [0100]), 10 to 50 wt% of polyethylene sorbitan fatty esters or calcium stearate (which is a surfactant which is solid at room temperature) (see paragraphs [0064] and [0099]), and which may further comprise at least one of a lubricating agent, a sweetener, a flavoring agent, a preservative such as propylparaben (which is insoluble in water), and/or a diluent material (see paragraphs [0088]-[0096]). The composition may further comprise proteins, antifungals, vitamin and mineral supplements, primrose oil, and/or fish and marine animal oils (see paragraphs [0055]-[0056]). The tablets of Pruss et al. are not spherical beads having an average bead size of 0.5 to 5 mm, and the molded bodies (tablets) of Pruss have a particle size above 5 mm.

21. Blending may be accomplished by means of lyophilization. In lyophilization, the dispersion is placed in a suitable vessel and frozen to a temperature of about -5°C to about -100°C. Under conditions of reduced temperature and pressure, the frozen solvent is removed by sublimation yielding a solid, porous material (see paragraph [0111] of Pruss et al.). Pruss et al. also teach that the lyophilization process described in

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Erbeia (US 4,178,695) may be used and is incorporated herein by reference. Erbeia teaches that in the freeze-drying process, cooling may be controlled to produce granulated substances, such as dividing a substance into particles by means of an adapted spray nozzle or distributed by moulding or extrusion in appropriate containers and then subsequently cooling the substance (pertaining to instant claim 12).

22. The amounts of xanthan gum, polyethylene sorbitan fatty esters or calcium stearate (which is a surfactant which is solid at room temperature) (see paragraphs [0064] and [0099]), at least one of a lubricating agent, a sweetener, a flavoring agent, a preservative such as propylparaben (which is insoluble in water), and/or a diluent material (see paragraphs [0088]-[0096]) overlap the instantly claimed ranges of water soluble polymeric material, surfactant, and water insoluble material of the instantly claimed invention. It is well settled that where the prior art describes the components of a claimed compound or compositions in concentrations within or overlapping the claimed concentrations a prima facie case of obviousness is established. See *In re Harris*, 409 F.3d 1339, 1343, 74 USPQ2d 1951, 1953 (Fed. Cir 2005); *In re Peterson*, 315 F.3d 1325, 1329, 65 USPQ 2d 1379, 1382 (Fed. Cir. 1997); *In re Woodruff*, 919 F.2d 1575, 1578 16 USPQ2d 1934, 1936-37 (CCPA 1990); *In re Malagari*, 499 F.2d 1297, 1303, 182 USPQ 549, 553 (CCPA 1974).

23. Pruss et al. do not elaborate on the intrusion volume of the polymeric materials of the invention. However, Pruss et al. teach identical materials which may used in identical amounts as are disclosed in the instantly claimed application. One of ordinary skill in the art would therefore reasonably expect the compositions of Pruss et al. to

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exhibit the same properties as the instantly claimed invention, including the specified intrusion volume. Case law holds that a material and its properties are inseparable. *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

Response to Arguments

24. Applicant's arguments, see page 10, filed November 12, 2009, with respect to claims 1 and 11 have been fully considered and are persuasive. The rejection of claims 1 and 11 under 35 U.S.C. 112 of claims 1 and 11 and the objection of the same claims has been withdrawn, due to the applicants defining of the scope of the claims.

Components (a) and (b) of claims 1 and 11 form a lattice, said lattice of which contains component (c) of claims 1 and 11.

25. Applicant's arguments with respect to claims 1, 4-8, and 10-21 have been considered but are moot in view of the new ground(s) of rejection.

26. However, applicant's arguments regarding the Wu et al. reference (specifically pages 14-15 of the arguments filed on November 12, 2009) are addressed below.

27. Applicant argues that the compositions of Wu et al. do not comprise water soluble porous bodies in a three-dimensional oil and water emulsion templated lattice. Applicant argues that the aqueous colloidal dispersion of the water-insoluble polymer of Wu et al. **is** a latex and when the latex is dried a powder is produced.

28. Applicant's argument is not persuasive.

29. Wu et al. teach the same amounts of the same substances as taught in the instant application. The materials of Wu et al. may be produced using a freeze-drying process, which is also disclosed in the instant invention. Therefore, one of ordinary skill in the art would reasonably expect the substances of Wu et al. to exhibit the same properties of the instantly claimed invention, including the intrusion volume and also solubility in water.

30. As to the applicant's argument regarding the compositions of Wu et al. not disclosing porous bodies which comprise a water insoluble material that is dispersed when a water soluble porous body dissolves, applicant's argument is not persuasive.

31. The limitation of claim 1 which teaches that the "water insoluble material incorporated into said lattice to be dispersed when the water soluble porous body dissolves" is a future intended use and describes what may happen to the porous bodies of the invention when dissolved in a substance. Case law holds that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Because Wu et al. teach the same materials which may be used in the same amounts to form lattice-like polymeric material, as are taught in the instant application, it is the examiner's position that the

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polymeric materials of Wu et al. are not structurally different than the porous bodies of the instant invention and would therefore behave the same.

32. To clarify, the examiner does not consider the oil-in-water polymeric emulsifier of Wu et al. (column 3, lines 51-53) corresponds to component (a) of claim 1 of the present application. The cellulose acetate material of Wu et al. (column 6, line 10) is the corresponding component. Cellulose acetate is not described as an emulsifier.

Cellulose acetate is a material other than the surfactant (which the present specification acknowledges is a water soluble polymeric material, see paragraph [0073]). The surfactant of Wu et al. may comprise polyoxyethylene sorbitan tristearate, which is both a solid at room temperature and has the specified HLB value. In addition to these materials, the composition of Wu et al. may comprise UV absorbers such as 2-hydroxy-4-methoxy benzophenone or octyl dimethyl para-amino benzoic acid (both of which are water insoluble) as well as lemon oil or orange oil fragrances (which are also water-insoluble). Therefore, the compositions of Wu et al. teach the limitations of claims 1, 4-8, 10, and 13-21.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KARA NEGRELLI whose telephone number is (571)270-7338. The examiner can normally be reached on Monday through Friday 9:30 am EST to 6:00 pm EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571)272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/KARA NEGRELLI/
Examiner, Art Unit 1796

/Randy Gulakowski/
Supervisory Patent Examiner, Art Unit 1796